

REMARKS

In the Office Action mailed August 23, 1988, the Examiner objected to the disclosure because of certain informalities. In response, Applicants have amended the disclosure as requested by the Examiner. Applicants appreciate the Examiner's attention in identifying these informalities.

Claims 25-32 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. The Examiner stated that the word "system" in Claims 25-27 should be deleted. In response, Applicants have deleted this word in Claims 25-27, as well as Claims 18-23. The Examiner also pointed out certain inconsistencies in the claims and lack of antecedents. In response, Applicants have amended the claims to correct the problems identified by the Examiner.

Claims 18-32 were rejected under 35 U.S.C. § 112, ¶ 1, as having a scope not commensurate with the disclosure. The Examiner indicated that the disclosure was enabling only for claims limited to an amplifier wherein the "laser fiber" comprises a crystal. Applicants respectfully disagree with this rejection. Although the specification discloses the preferred embodiment of the invention in the context of a laser fiber which comprises a crystal material, it was well known in the art, prior to filing the application, that materials other than crystal could be used in laser fibers. For example, a book entitled "Lasers" by Bela A. Lengyel, published in 1971 by John Wiley & Sons, includes a rather extensive discussion of various types of laser materials. As indicated on pages 158-163 of that book, a copy of which is attached, lasers can be made from materials other than crystals,

such as neodymium glass (see especially pages 161-163). Further, the use of neodymium glass in fiber lasers has been known for at least two decades, as evidenced by "Amplification in a Fiber Laser," C. Koester, et al., Applied Optics, vol. 3, no. 10 (1964), a copy of which is attached. Accordingly, it is simply not true that the disclosure is enabling only for crystal materials. The literature clearly indicates that anyone of ordinary skill in the art would readily recognize the applicability of other materials.

Moreover, in mechanical cases, it has been held that specific embodiments may support broad claims. For example, in Beale v. Schuman, the Patent and Trademark Office Board of Interferences stated:

"The fact that the claims in the Schuman reissue application may read not only on structures that have at least one gas passage on the cylinder, but also on structures that have at least one gas passage on the piston and cylinder is not precluded by the requirements of 35 U.S.C. § 112, first paragraph, since as pointed out in In re Newton, supra, in a mechanical case broad claims may be supported by a specific embodiment and as pointed out in In re Joffe, supra, an inventor need not limit his claims to precisely what he has found will work in order to ease the path of a would-be infringer." 212 U.S.P.Q. 291, 294 (1980).

Similarly, the Court of Appeals for the District of Columbia has stated:

"Moreover, even if the claim language may include laser oscillators, that would not bar appellant from supporting his claim by disclosing only an amplifier. Under the settled rule that a broad mechanical claim can be supported by disclosure of a single embodiment of the claimed invention, a claim can be sustained even if it covers other inoperative or inadequately disclosed forms of the invention." 219 U.S.P.Q. 393, 396 (1983).

In view of the foregoing, Applicants submit that the disclosure fully meets the requirements of § 112 for Claims 18-32 and that the rejection should be withdrawn.

The Examiner also rejected Claim 32 under 35 U.S.C. § 112, ¶ 1, on the basis that the disclosure was enabling only for claims limited to the use of particular wavelengths rather than wavelength "spectra." Applicants submit that enablement is not an issue with respect to this claim, since there would appear to be little question that one skilled in the art, as of the time of filing the application, could make the claimed invention on the basis of Applicants' disclosure. In Applicants' opinion, the only arguable question concerning Claim 32 is whether it meets the "written description" requirement of § 112. To avoid any problems concerning the written description requirement, Applicants have amended Claim 32 to remove any reference to wavelength "spectra," and has used instead the more generic term "wavelength."

Applicants have made additional amendments to the claims to improve their form and to make certain that there are no double patenting problems with respect to U.S. Patent No. 4,723,824, a


copy of which is attached. It is believed that, inter alia, the term "waveguide" in the pending claims removes any concerns with respect to double patenting. However, Applicants would appreciate the Examiner's independent review of this matter.

In view of the foregoing, Applicants submit that the claims are now in a condition for allowance, and respectfully requests that the application be passed to issue.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR

Dated: Oct 10, 1988

By:  ✓
William H. Nieman
Registration No. 30,201
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660
(714) 760-0404

WHN-5219:am1/bb2/bam3
101088

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on OCT 10, 1988


William H. Nieman, Reg. #30,201